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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,684

03/20/2006

Shigeyuki Ono

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

03/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/572,684	ONO ET AL.	
	Examiner	Art Unit	
	Greg Binda	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Drawings

1. Figures 10 & 11 should each be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
2. The drawings are objected to because:
 - a. The hatching pattern used in Figs. 1-3 & 6-9 to depict the rubber or elastic plastic adaptor 20 is inappropriate. See MPEP § 608.02 for the appropriate pattern.
 - b. Reference numerals 2+ are used to identify features in Figs. 1-3 and then reused to identify modifications of those features in Figs. 4-9. Such usage is proscribed. See MPEP § 608.02(e).
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because:
 - a. The patent documents referenced at page 3, lines 6 & 22 must be identified by a publication number or be stricken from the disclosure.
 - b. The summary is not written in narrative form. The text at page 5, lines 4+ is a single run-on sentence.
 - c. The brief description of the drawings fails to precede the detailed description of the invention.
5. The abstract of the disclosure is objected to because the first seventeen lines comprise a single run-on sentence. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9 recites the limitation, “[the rubber or elastic plastic adaptor includes] a cutout formed from the reversing portion to the folding portion”. Applicant has not pointed out where this limitation is supported, nor does there appear to be a written description of the limitation in the application as originally filed. The original disclosure describes such a cutout only when the adaptor is made from a material that resists deformation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 6, 7, 9 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zenichi, JP 1992-116022. Figs. 1-6 show a universal joint boot comprising: a boot body 20 including a cylindrical bellows part that has valleys and peaks formed continuously in a repetitive manner and can extend and contract and an opening portion which is formed in one end of the bellows part and into which a case 22 for receiving one member of two members moving relatively to each other is inserted; and

an annular adaptor 27-31 that is mounted on an inner peripheral surface of the opening portion and has an outer peripheral surface formed nearly in the same shape as the inner peripheral surface,

wherein that the adaptor which is formed of rubber or elastic plastic (to the same extent as the instant adapter 20 at instant Figs. 4 & 5) has:

a fixing portion 28 that is pressed by the inner peripheral surface of the opening portion of the boot body, thereby being fixed to the case;

a reversing portion 29 that is located opposite to the fixing portion with the opening portion between them and sandwiches the opening portion together with the fixing portion; and

a folding portion 27 where the reversing portion is folded back outside.

Fig. 2 shows a cutout is formed from the reversing portion to the folding portion. Fig. 6 shows the reversing portion has a mounting portion on which a band 11 is mounted in a state where the reversing portion is folded back from the folding portion.

10. Claims 6, 7, 9 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Haruo, JP 1990-98221. Figs. 1-5 show a universal joint boot comprising:

a boot body 1 including a cylindrical bellows part that has valleys and peaks formed continuously in a repetitive manner and can extend and contract and an opening portion which is formed in one end of the bellows part and into which a case 3a for receiving one member of two members moving relatively to each other is inserted; and

an annular adaptor 2 that is mounted on an inner peripheral surface of the opening portion and has an outer peripheral, surface formed nearly in the same shape as the inner peripheral surface,

wherein that the adaptor which is formed of rubber or elastic plastic (to the same extent as the instant adapter 20 at instant Figs. 4 & 5) has:

a fixing portion 2a that is pressed by the inner peripheral surface of the opening portion of the boot body, thereby being fixed to the case;

a reversing portion 2b that is located opposite to the fixing portion with the opening portion between them and sandwiches the opening portion together with the fixing portion; and

a folding portion 2c where the reversing portion is folded back outside.

Fig. 3 shows a cutout 2d is formed from the reversing portion to the folding portion. Fig. 5 shows the reversing portion has a mounting portion on which a band 9 is mounted in a state where the reversing portion is folded back from the folding portion.

11. Claims 6-8 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Konegen, US 5,836,824. Figs. 1-3 show a universal joint boot comprising:

a boot body 11 including a cylindrical bellows part that has valleys and peaks formed continuously in a repetitive manner and can extend and contract and an opening portion 12 which is formed in one end of the bellows part and into which a case 13 for receiving one member of two members moving relatively to each other is inserted; and

an annular adaptor (see “U-shaped sheathing” at col. 4, line 20) that is mounted on an inner peripheral surface of the opening portion and has an outer peripheral, surface formed nearly in the same shape as the inner peripheral surface,

wherein that the adaptor which is formed of rubber or elastic plastic (col. 4, line 36) has:

a fixing portion that is pressed by the inner peripheral surface 36 of the opening portion of the boot body, thereby being fixed to the case;

a reversing portion that is located opposite to the fixing portion with the opening portion between them and sandwiches the opening portion together with the fixing portion; and

a folding portion where the reversing portion is folded back outside.

Fig. 2 shows a protruding portion (nominally indicated by reference numeral 33) for pressing an outer peripheral portion of the opening portion inwardly. Fig. 3 shows that an outer periphery of the fixing portion 40 has an uneven surface (see also “flutes” in col. 4, line 42) in contact with an inner periphery of the boot. Figs. 2 & 3 shows the reversing portion has a mounting portion on which a band 35 is mounted in a state where the reversing portion is folded back from the folding portion.

12. Claims 6 & 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Weiler, US 4,832,161. Fig. 1 shows a universal joint boot comprising:

a boot body 16 including a cylindrical bellows part that has valleys and peaks formed continuously in a repetitive manner and can extend and contract and an opening portion 18 which is formed in one end of the bellows part and into which a case 4 for receiving one member of two members moving relatively to each other is inserted; and

an annular adaptor 42 that is mounted on an inner peripheral surface of the opening portion and has an outer peripheral, surface formed nearly in the same shape as the inner peripheral surface,

wherein that the adaptor which is formed of rubber or elastic plastic has:

a fixing portion 44 that is pressed by the inner peripheral surface of the opening portion of the boot body, thereby being fixed to the case;

a reversing portion 50 that is located opposite to the fixing portion with the opening portion between them and sandwiches the opening portion together with the fixing portion; and

a folding portion 48 where the reversing portion is folded back outside.

Fig. 1 shows a protruding portion 46 for pressing an outer peripheral portion of the opening portion inwardly.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hazebrook and Messenger each show a universal joint boot with a annular adaptor part that is formed of rubber or elastic plastic. Couraud shows an annular adaptor part that is formed of rubber or elastic plastic

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Binda/
Primary Examiner, Art Unit 3679